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To: **Mail Stop Appeal Brief- Patents**
Examiner William L. Miller, GAU: 3677
Fax No.: (703) 872-9306
From: George M. Macdonald
Date: October 13, 2004
Subject: Serial No.: **09/683,417**
Pages: 11 (including this cover)

Re: U.S. Patent Application Serial No.: 09/683,417
Confirmation No.: 2989
Our Docket # F-428

Enclosed please find Appellants' Brief on Appeal and a petition for one-month extension of time.

CERTIFICATION OF FACSIMILE TRANSMISSION

I hereby certify that the following correspondence is being transmitted
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1. Petition for One-Month Extension of Time and Fee (1 page); and
2. Appellant's Brief on Appeal (9 pages).

on October 13, 2004
Date of Transmission


Signature

George M. Macdonald
Name of Registered Rep.
Reg. No.: 39,284

October 13, 2004
Date

Serial No.: 09/683,417
Attorney Docket No.: F-428

Patent

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES**

In re patent application of:

) Attorney Docket No.: F-428

) Customer No.: 00919

Denis J. Stemmler

)

)

Serial No.: 09/683,417

)

Filed: December 24, 2001

) Examiner: MILLER, WILLIAM L.

Confirmation No.: 2989

) Group Art Unit: 3677

) Date: October 13, 2004

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Title: METHOD AND SYSTEM FOR DECONTAMINATING MAIL

Mail Stop Appeal Brief- Patents
Commissioner for Patents
Alexandria, VA 22313-1450

APPELLANT'S BRIEF ON APPEAL

Sir:

This is an appeal pursuant to 35 U.S.C. § 134 and 37 C.F.R. §§ 1.191 et seq. from the final rejection of claims 26-27 and 34 of the above-identified application mailed April 13, 2004. Claims 26-27 and 34 stand at least twice rejected. This Brief is in furtherance of the Notice of Appeal filed in this case on July 13, 2004. A petition for a one-month extension to file the brief and fee is submitted herewith. Accordingly, this brief is timely filed. The fee for submitting this Brief is \$340.00 (37 C.F.R. § 1.17(c)). Please charge Deposit Account No. 16-1885 in the amount of \$340.00 to cover these fees. The Commissioner is hereby authorized to charge any additional fees that may be required for this appeal or to make this brief timely or credit any overpayment to Deposit Account No. 16-1885.

CERTIFICATE OF FACSIMILE TRANSMISSION

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George M. Macdonald, Reg. No. 39,284 (Name of Registered Rep.)


(Signature)

October 13, 2004 (Date)

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I. Real Party in Interest

The real party in interest in this appeal is Pitney Bowes Inc., a Delaware corporation, the assignee of this application.

II. Related Appeals and Interferences

There are no appeals or interferences known to Appellant, his legal representative, or the assignee that will directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

III. Status of Claims

Claims 26-27 and 34 are in the case and under final rejection of the Examiner and stand rejected under 35 U.S.C. § 103(a) as allegedly being rendered obvious by U.S. Patent Application Publication No. US 2004/0020978 A1 by Webb ("Webb '978") in view of U.S. Patent No. 5,920,075 issued to Whitehead ("Whitehead '075").

Appellants hereby appeal the rejection of claims 26-27 and 34.

IV. Status of Amendments

There are no amendments to the claims filed subsequently to the final rejection of April 13, 2004. Therefore, the claims set forth in Appendix A to this brief are those as set forth before the final rejection.

V. Summary of Claimed Subject Matter

Appellant's invention relates to methods and systems for decontaminating mail during a relatively long period of time in a mailbox. Figure 4a is reproduced below.

As described in paragraphs 63-65 and as shown in FIG. 4a, a mailbox 410 includes a controller 450. UV C radiation sources at 260 nm 430, 432 are connected to a controller 450. The controller 450 is connected to a decontamination start switch 470, a timer and a display 418. The mailbox 410 is shielded to prevent UV C radiation from escaping and is reflective. The mailbox interior has dividers 440 that allow the UV C energy to bathe the surfaces of each mail piece placed in each of the slots created by dividers 440. Divider bottom 442 is at least partially transparent to UV and allows UV C energy to bathe the bottom surfaces of the mail pieces. The postal worker places the mail in the mailbox, closing the door. The postal worker uses a key to turn the switch 470 to start the decontamination and the postal worker leaves.

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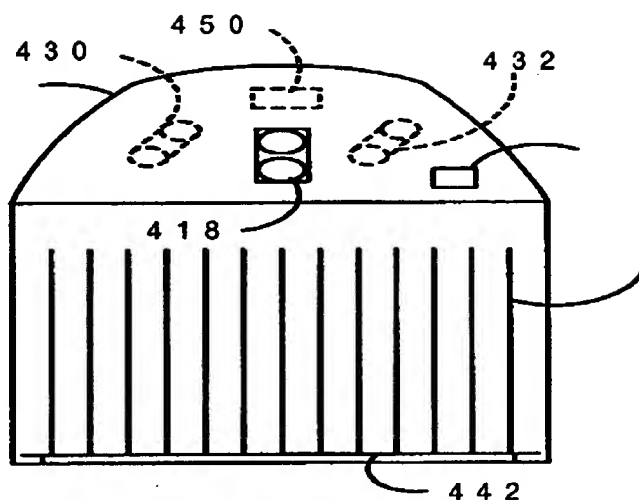


FIG. 4A

The display 418 displays a warning and the door is locked. The UV C lights are lit for a predetermined time such as three hours and provide at least 20 milliwatts per centimeter squared of 260-nanometer light. One or 5 hours may be utilized, however, other time periods may be effective. After the predetermined time expires, the door is unlocked and the display indicates it is safe to open the door and retrieve the mail.

As described in paragraph 76, the mailbox may utilize a communications channel and communications device to provide an indication inside a home in step 720 that "the mail has arrived" followed in step 750 by an indication that "the mail is being sanitized" and then followed in step 770 by an indication that "it is now safe to pick up and open your mail."

Additional features of the invention are discussed below in the Argument section of this Brief. This summary is not intended to supplant the description of the claimed subject matter as provided in the claims as recited in Appendix A, as understood in light of the entire specification.

VI. Grounds of Rejection to be Reviewed on Appeal

Whether claims 26-27 and 34 are patentable under 35 U.S.C. §103(a).

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VII. Argument

As Appellant discusses in detail below, the final rejection of claims 26-27 and 34 is unsupported by the references of record and is therefore devoid of any factual or legal premise that supports the position of unpatentability. It is respectfully submitted that the rejection does not even meet the threshold burden of presenting a prima facie case of unpatentability. For this reason alone, Appellant is entitled to grant of a patent. In re Oetiker, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992).

A. The Webb '978 Reference is Not Properly Combined Under 35 U.S.C. Section 103(a)

Initially, the Examiner relies on the filing date of a related provisional patent application of the Webb '978 reference, yet does not provide a copy of the earlier reference to support entitlement to the earlier filing date for the material cited. Accordingly, the current record does not support that the Webb '978 reference is available as prior art.

Appellant also respectfully submits that there is no motivation to combine the references. For the rejection to stand, there must be some teaching, suggestion or motivation to combine the references found in the references themselves or the general knowledge of one of skill in the art. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1998); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). However, the Examiner used the invention itself as the roadmap to justify combining non-analogous references by stating that

it would have been obvious to one of skill in the art at the time the invention was made to modify Webb by utilizing a keyed start switch in conjunction with a keypad to send a decontamination start signal to the decontamination system and thereby provide a safety feature allowing authorized use only.

April 13, 2004 Final Office Action, section 6. However, the Webb '978 reference does discuss safety and never contemplates using a keyed authorized access system. Webb '978 describes only using a door lock while the decontamination is in progress. Whitehead '075 on the other hand describes using an uncontained UV beam and thus discusses a safety mechanism to ensure the key

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is inserted for the whole contamination cycle, not as a system for access control. Accordingly, Appellant respectfully submits that the references are not properly combined.

B. Claims 26-27 and 34 are not Unpatentable under 35 U.S.C. § 103(a)

Claims 26-27 and 34 are in the case and under final rejection of the Examiner and stand rejected under 35 U.S.C. § 103(a) as allegedly being rendered obvious by U.S. Patent Application Publication No. US 2004/0020978 A1 by Webb ("Webb '978") in view of U.S. Patent No. 5,920,075 issued to Whitehead ("Whitehead '075").

In rejecting a claim under 35 U.S.C. §103, the Examiner is charged with the initial burden for providing a factual basis to support the obviousness conclusion. *In re Wamer*, 379 F.2d 1011, 154 USPQ 173 (CCPA 1967); *In re Lunsford*, 375 F.2d 385, 148 USPQ 721 (CCPA 1966); *In re Freed*, 425 F.2d 785, 165 USPQ 570 (CCPA 1970). The Examiner is also required to explain how and why one having ordinary skill in the art would have been led to modify an applied reference and/or combine applied references to arrive at the claimed invention. *In re Ochiai*, 37 USPQ2d 1127 (Fed. Cir. 1995); *In re Deuel*, 51 F.3d 1552, 34 USPQ 1210 (Fed. Cir. 1995); *In re Fritch*, 972 F.2d 1260, 23 USPQ 1780 (Fed. Cir. 1992); *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988). In establishing the requisite motivation, it has been consistently held that both the suggestion and reasonable expectation of success must stem from the prior art itself, as a whole. *In re Ochiai*, supra; *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Dow Chemical Co.*, 837 F.2d 469, 5 USPQ2d 1529 (Fed. Cir. 1988).

Claim 26 is directed to a system for decontaminating mail and is shown below:

- 26. A mailbox for decontaminating mail comprising:
 - a door for allowing access to the interior of the mailbox;
 - a decontamination system operatively connected to a controller for decontaminating mail;
 - at least one divider for separating mail; and

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a keyed start switch used to send a decontamination start signal to the decontamination system. (emphasis added).

Appellant respectfully disagrees with the rejection of the claim and urges its reversal for at least the reasons stated below.

In the April 13, 2004 Final Office Action, the Examiner cited for the first time and applied the Webb '978 reference in rejecting claims 26-27 and 34 under 35 U.S.C. section 103(a). As discussed above, as the underlying provisional application has not been provided to show entitlement to the date asserted, the reference is not available as prior art.

The Examiner cites to Whitehead '075 to show a decontamination start signal. However, as is clear from FIG. 3 of Whitehead '075, the key does not send a start decontamination cycle signal, but merely opens the power supply circuit (see reference 60). The keypad 70, digital lock circuit 100 operates the switch 110 to start the light source. Accordingly, Appellant respectfully submits that the cited references do not teach or suggest a keyed start switch as claimed.

Furthermore, as discussed above, Appellant respectfully submits that the references are not properly combined. For example, the Webb '978 reference does discuss safety and never contemplates using a keyed authorized access system. Webb '978 describes only using a door lock while the decontamination is in progress. Whitehead '075 on the other hand describes using an uncontained UV beam and thus discusses a safety mechanism to ensure the key is inserted for the whole contamination cycle, not as a system for access control.

Claim 27 depends from claim 26 and is directed to another system for decontaminating mail and is shown below:

27. The mailbox of claim 26, wherein

the controller includes a communications device for providing status information to a user. (emphasis added).

Appellant respectfully disagrees with the rejection of the claim and urges its reversal for at least the reasons stated below.

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As shown in paragraph 76, the communications device is capable of communicating messages and is in contrast to the lamps cited by the Examiner in section 7 of the Final Office Action that show an indicator that is not included in the controller. Mere status indicators are described in paragraph 52 and are clearly distinguished from the communications device described in paragraph 76 of the specification.

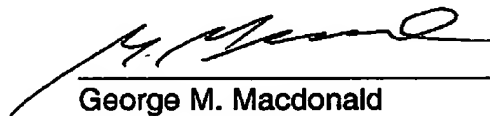
Independent claim 34 is patentable over the cited references for at least the same reasons as described above with reference to claim 26.

Accordingly, the Examiner has failed to establish a prima facie case for an obviousness rejection. For at least the reasons stated, Appellant respectfully submits that the final rejection as to claims 26-27 and 34 is in error and should be reversed.

Conclusion

In Conclusion, Appellant respectfully submits that the final rejection of claims 26-27 and 34 is in error for at least the reasons given above and should, therefore, be reversed.

Respectfully submitted,



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VIII CLAIMS APPENDIX
APPENDIX A

26. A mailbox for decontaminating mail comprising:

a door for allowing access to the interior of the mailbox;

a decontamination system operatively connected to a controller for decontaminating mail;

at least one divider for separating mail; and

a keyed start switch used to send a decontamination start signal to the decontamination system.

27. The mailbox of claim 26, wherein

the controller includes a communications device for providing status information to a user.

34. A decontaminating device including a decontamination chamber comprising:

a door for allowing access to the interior of the decontamination chamber;

a decontamination system operatively connected to a controller for decontaminating mail;

at least one divider for separating mail; and

a keyed start switch used to send a decontamination start signal to the decontamination system.